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*Amendment*  
*Attorney Docket No. S63.2N-8429-US03*

### **Remarks**

This Amendment is in response to the Office Action dated **October 22, 2004**, wherein claims 60 and 61 were withdrawn by the Examiner; claim 34 was rejected as being grammatically awkward; claims 51-62 were rejected under 35 U.S.C. §112, second paragraph; claims 34-36, 39-43, 47, 9, 50 and 62 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. 6,348,065 to Brown et al (Brown) in view of U.S. 5,449,373 to Pinchasik et al (Pinchasik); and claims 51-59 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. 5,733,303 to Israel et al (Israel) in view of U.S. 5,807,404 to Richter et al (Richter).

The following comments are presented in the same order and with paragraph headings corresponding to the Office Action.

### **Election Restriction**

In the Office Action claims 60 and 61 were withdrawn from further consideration as being drawn to a non-elected species. More specifically, the Examiner states that "claims 60 and 61 were withdrawn because no support could be found for 'circumferentially aligned' joining struts in Figure 10F."

Instant claim 60 refers, in part, to cells that are defined by the components of adjacent expansion columns and the connecting struts therebetween. Applicant notes that FIG. 10F illustrates a connecting strut design which can be used in any of the embodiments discussed in the Application (see page 22, lines 13-15), but that the actual figure depicts only a small portion of the stent which it may be a part. Thus, in order to properly assess claims directed to a stent that includes the connecting strut design shown in FIG. 10F, it is necessary to superimpose the connector shown in FIG. 10F onto a stent having expansion columns similar to what are shown or that are supported by the original disclosure. For example, a stent such as is shown in FIG. 8D has a configuration of expansion columns similar to that of FIG. 10F, and one of ordinary skill will recognize that the connecting strut of FIG. 10F is easily substituted for the connecting elements shown in FIG. 8D. One of ordinary skill will recognize that such a stent when embodied with the connecting strut of FIG. 10F will include "one of the first joining struts in the first cell circumferentially aligned and longitudinally offset from one of the second joining struts" as instant claim 60 recites.

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In light of the above, Applicant asserts that claims 60 and 61 do in fact read on the elected species M, corresponding to FIG. 10F. As such, the Examiner's withdrawal of claims 60 and 61 should itself be withdrawn.

#### **Claim Objections**

In the Office Action claim 34 was objected to as being grammatically awkward, in that the phrase "is closer one third" should be —is closer to one third—. As indicated above, Applicant has amended claim 34 in the manner requested.

#### **Claim Rejections – 35 U.S.C. §112**

In the Office Action claims 51-62 are rejected under 35 U.S.C. §112, second paragraph. More specifically the Examiner states that "since there is no inherently round or cylindrical structure claimed for the stent, the terminology 'the circumference of the stent' lacks antecedent basis rendering the claim language indefinite".

Applicant respectfully asserts that this rejection is an unwarranted and erroneous application of §112, particularly in light of the Examiner's extensive familiarity and knowledge of the present Application and its siblings. Applicant submits that as matter of record, terms referring to the "round nature" of the stent claimed have been consistently and repeatedly used in virtually every claim set that has ever been submitted for examination, (for example, see the preliminary amendment of August 7, 2001 wherein the stent is described as having a "circumferentially" offset connecting strut, among other uses of the word "circumferentially") and that the Examiner has never, until now, asserted that the claims were indefinite for failing to include reference to a round or cylindrical "structure". It is also a matter of record that the Examiner has reviewed and examined the present Application and its claims on at least five occasions over the nearly four year period that the Application has been pending, and that the Examiner has had ample opportunity to reject the claims as being indefinite for the reason only now stated in the most recent instant Office Action, and that his failure to do so indicates that the claims were not, and are not now, indefinite under §112 (See Office Actions dated November 8, 2002; April 3, 2003; November 17, 2003; March 31, 2004, September 8, 2004). In light of the

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above, Applicant requests that the rejection be withdrawn.

The specific rejections to claim 58, and especially claim 60, are fully addressed by the comments above.

**Claim Rejections – 35 U.S.C. §103**

In the Office Action claims 34-36, 39-43, 47, 49, 50 and 62 were rejected under §103(a) as being obvious over Brown in view of Pinchasik. In the Office Action it is asserted that it would have been obvious to make the connectors of Brown curved for the same reason that Pinchasik does the same and in order to better support the area.

In response Applicant respectfully asserts that there can be no motivation to combine the references in the manner proposed by the Examiner without the impermissible use of hindsight reasoning.

Looking first to the stent of Brown, the stent described in Brown is said to have adjacent segments which are displaced relative to each other to accommodate flexing of the stent within the segments rather than by means of articulating flexible connectors between segments. The connectors between the segments are *not* intended to flex or bend under normal use (column 2, lines 29-39). This is in direct contrast to the disclosure of Pinchasik wherein the articulated stent of the invention comprises *flexible* connectors connecting substantially rigid segments (see, for example, col. 2, lines 17 and 23). One of ordinary skill would not seek to modify the stent of Brown in a manner contrary to Brown's own teaching, in by removing connectors, which Brown says are *not* intended to flex, with the connectors of Pinchasik, which are necessarily flexible.

Given the contrary teachings in the cited references, it seems clear that the motivation to combine proposed by the Examiner would only be apparent to "one of ordinary skill in the art" when the cited references are viewed through the lens of hindsight reasoning afforded by the present Application. Such use of hindsight reasoning is prohibited when attempting to establish a §103 obviousness rejection (see *Ruiz v. A.B. Chance Co.*, 69 USPQ2d 1686, 1690 (CA FC 2004)).

In addition to the above, it must be noted that given the statement in Brown that the connectors are not intended to flex, one of ordinary skill will recognize that modifying Brown to include the flexible connectors of Pinchasik will inherently destroy the stated function in

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Brown of connectors that are not intended to flex. It is recognized that when an attempt is made to combine two references, or to change a single reference, in an effort to establish §103 obviousness, a *prima facie* case of obviousness has not been established if the intended purpose or function of either reference, or both, is destroyed by their combination. (see: *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In light of the above, the rejection is respectfully traversed.

In the Office Action claims 51-59 are rejected under §103(a) as being obvious over Israel in view of Richter. To clarify however, the Office Action does not seek to modify Israel in view of Richter, rather the Office Action indicates that while both references fail to meet all of the elements of the instant claims it would be a matter of design choice to circumferentially offset the ends of the connectors of *either* reference.

In rejecting the claims however, the Office Action provides no indication of motivation in either reference to make the proposed modification(s), and instead states that "it would have been an obvious matter of design choice to a person of ordinary skill in the art to circumferentially offset the ends of the connectors because Applicants have not disclosed that doing so provides some advantage, is used for a particular purpose, or solves a stated problem." Applicant respectfully asserts however, that the Examiner's view of what advantage or purpose the "Applicant[s]" did or did not disclose is irrelevant to the finding of obviousness. §2143.01 of the MPEP states that §103 obviousness "can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly *in the references themselves* or in the knowledge generally available to one of ordinary skill in the art. (emphasis added).

Presumably because the cited references do not provide the necessary "teaching, suggestion, or motivation" the Examiner states that one of ordinary skill in the art "would have expected Applicants' invention to perform equally well because a slight position change of the ends is all that is required to meet the claim language and because it would not appreciably change the function of the stent to have a slight offset." An expectation of a given performance characteristic is not a teaching, suggestion or motivation to make the modification in the first

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place. While the performance expectations of one of ordinary skill in the art may be relevant to design choices, it is still necessary to provide a teaching, suggestion, or motivation to make the proposed modification in order to establish §103 obviousness. One of ordinary skill in the art may expect all sorts of things, but absent some teaching or suggestion in the cited art or in the knowledge generally available to make the stated modification, a finding of obviousness based solely on the Examiner's view of performance expectations is improper.

In light of the above, the rejection is respectfully traversed.

### Conclusion

In view of the foregoing, Applicant believes that the present application, with claims 34-36, 39-43, 47 and 49-62 is in condition for allowance. Favorable consideration and prompt action to that effect is sincerely requested.

Should the Examiner believe that anything further would be desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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